

## **REMARKS**

The Non-Final Office Action mailed January 20, 2010, allowed claims 10–13, 17–20, 24–34 and 39–41. Claims 14, 16, 21, 23, and 35–38 were rejected. Claims 15 and 22 were objected. Claims 14, 16, 21, 23 and 35–38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakkinen, U.S. Patent No. 5,839,056 (filed Aug. 30, 1996) (hereinafter Hakkinen) in view of Soliman, U.S. Patent No. 6,101,179 (filed Sep. 19, 1997) (hereinafter Soliman).<sup>1</sup>

By this response, no claims are amended such that claims 10–41 remain pending. Claims 14, 16, 21, and 23 are independent claims which remain at issue (with all other independent claims having been indicated as allowed).

### **Claim Rejections Under 35 U.S.C. § 103(a):**

Claims 14, 16, 21, 23, and 35–38 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Hakkinen and in view of Soliman.<sup>2</sup> The Applicants submit that Soliman fails to qualify as prior art for purposes of 35 U.S.C. § 103(a) and therefore the rejections of claims 14, 16, 21, 23, and 35–38 under 35 U.S.C. § 103(a) as being unpatentable in view of Hakkinen and in view of Soliman should be withdrawn.

In particular, the Soliman reference, U.S. Patent No. 6,101,179, was filed on Sep. 19, 1997.<sup>3</sup> The Office did acknowledge the claim for foreign priority based upon the application filed in Japan on Apr. 17, 1997.<sup>4</sup> However, the Office noted “that applicant has not filed a certified copy of the 116,192/1997 application as required by 35 U.S.C. 119(b).”<sup>5</sup>

This application (Ser. No. 10/674,003) is a divisional application of U.S. Patent App. Ser. No. 09/403,161 which is the U.S. national phase application of PCT/JP98/01786. For PCT/JP98/01786, the international bureau dispatched a copy of the priority document (i.e., a certified copy of the original Japanese application) to the USPTO. As the relevant priority

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<sup>1</sup> Please note that the prior art status of the cited art is being challenged at this time. In particular, the Applicant submits that the Soliman reference fails to qualify as prior art for purposes of the asserted rejections. Further, Applicant reserves the right to challenge the prior art status of any cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

<sup>2</sup> Office Communication p. 2 (paper no. 01152010, Jan. 20, 2010).

<sup>3</sup> See Soliman.

<sup>4</sup> Office Comm. p. 2.

<sup>5</sup> Office Comm. p. 2.

documents have already been submitted and accepted by the Office for the parent application, the Applicants submit that a separate and additional filing of a certified copy of the Japanese 116,192/1997 application is unnecessary.

We have included with this response a copy of the Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495, dated Feb. 14, 2000 (hereinafter Notice of Acceptance) which was issued for parent Application Ser. No. 09/403,161 and which shows that the Office received the Priority Document for the parent patent application.<sup>6</sup> The copy of the priority document sent to the U.S. Patent and Trademark Office from the International Bureau "is acceptable to establish that applicant has filed a certified copy of the priority document."<sup>7</sup> As the Notice of Acceptance shows receipt by the USPTO of the priority document and as the priority date of the parent application is Apr. 17, 1997, the Applicants respectfully submit that a separate submission of a certified copy of the priority document for this divisional application should be unnecessary. Further, as the Japanese filing date of the priority document is Apr. 17, 1997, the Applicants submit that the Soliman reference, filed Sep. 19, 1997, fails to qualify as prior art for purposes of rejections under 35 U.S.C. § 103(a).

We have also included with this response an English translation of the Japanese Application No. 116,192/1997 (9-116192) and an executed Verification of Translation declaring the included English translation is a true and correct translation of the international application.

Because the Office has already received and has on file for parent Application Ser. No. 09/403,161 the requisite priority document with a priority date of Apr. 17, 1997, the Applicants submit that Soliman (filed Sep. 19, 1997) fails to qualify as prior art. Accordingly, the rejections of Claims 14, 16, 21, 23, and 35–38 under 35 U.S.C. § 103(a) as being unpatentable in view of Hakkinen and in view of Soliman should be withdrawn. As all rejections of these (or other) claims relied upon the disqualified Soliman reference, the Applicants respectfully request the prompt allowance of all still-pending claims.

#### **Claim Objections:**

Claims 15 and 22 were "objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

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<sup>6</sup> See Notice of Acceptance.

<sup>7</sup> See MPEP § 1893.03(c).

claim and any intervening claims.”<sup>8</sup> Claims 15 and 22 are dependent upon claims 14 and 21, respectively. As noted above, the rejections of claims 14 and 21 under 35 U.S.C. § 103(a) rely upon the Soliman reference which should be disqualified as prior art. Accordingly, as independent claims 14 and 21 should be allowable, so too should dependent claims 15 and 22. Accordingly, the Applicants respectfully request the objections to claims 15 and 22 now be withdrawn.

In view of the foregoing, Applicant respectfully submits that other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; and/or (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefore and charge any additional fees that may be required to Deposit Account No. 23-3178.

In accordance with the amendments and discussion presented herein, the Applicants respectfully request favorable reconsideration of each of the pending claims. In the event that

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<sup>8</sup> Office Comm. p. 6.

the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at 801-533-9800.

Dated this 20<sup>th</sup> day of April, 2010.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Tom M Bonacci". The signature is fluid and cursive, with a large, stylized "B" and a long, sweeping underline.

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